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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,428	12/03/2003	Laurence Anthony Sinnige	04866.0008	5315
7590	06/17/2004			
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315			EXAMINER REDDICK, MARIE L	
			ART UNIT 1713	PAPER NUMBER

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,428	<b>Applicant(s)</b> SINNIGE, LAURENCE ANTHONY
	<b>Examiner</b> Judy M. Reddick	<b>Art Unit</b> 1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 12/03/03, 03/16/04 & 04/29/04.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 03/16/04.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date, \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

**Information Disclosure Statement**

1. The information disclosure statement filed 03/16/04 has been considered and scanned into the application file.

**Specification**

2. The disclosure is objected to because of the following informalities: On page 6, line 18 and page 7, in the Table, it is believed that the characterization of Run A, as a comparative sample is in error. It is believed that "Comparative sample A" is actually "Inventive sample A". Further, the table on page 7 should be properly labeled as "TABLE".

Appropriate correction is required.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: As far as the Examiner can tell, antecedent basis for "synthetic wax esters" and "acid waxes" per claim 7, has not been established.

**Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.
5. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - A) The recited "polyolefin-maleic anhydride graft polymer" per claim 1 constitutes indefinite subject matter as per the metes and bounds of such engender indeterminacy in scope.
  - B) The recited "chosen from the group comprising" per claim 5 constitutes indefinite subject matter as per the use of improper Markush Language. When materials recited in a claim

Art Unit: 1713

are so related as to constitute a proper Markush group, they should be recited in the conventional manner, or in the alternative. For example, "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, or alternatively, "wherein R is A, B, C or D" is also proper. See M.P.E.P. § 2173.05(h).

C) The recited "wherein the polyvinyl alcohol comprises at least 80 % hydrolyzed polyvinyl acetate" per claim 7 constitutes indefinite subject matter as per it not being readily ascertainable if the degree of hydrolysis is based on "mole" or "weight" percent.

D) The recited "carnauba wax", "synthetic wax esters", "acid waxes" and "maleated hydrocarbons" per claim 7 constitute indefinite subject matter as per it not being readily ascertainable as to how the recited "wax" species further limits the antecedently recited "hydrocarbon wax" genus and the term "carnauba" is not an art-recognized compound. Perhaps applicant intended "carnauba" instead of "carnuba".

#### **Allowable Subject Matter**

6. No anticipatory art has been found. Claims 1-7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. The instantly claimed invention is deemed allowable over the prior art of record as per said art neither anticipating nor rendering obvious the precisely defined aqueous emulsion comprising a hydrocarbon wax, a polyolefin-maleic anhydride graft polymer and polyvinyl alcohol, as claimed. One having ordinary skill in the art would not have been endowed with any motivation to extrapolate, from any of the disclosures of the prior art of record, the precisely defined aqueous emulsion comprising a hydrocarbon wax, a polyolefin-maleic anhydride graft polymer and a polyvinyl alcohol, as claimed, with any reasonable expectation of success. The closest prior art to Kuroda et al(U.S. 4,748,196) teach, basically, a water-repellent composition defined basically as containing an emulsion prepared by emulsifying in water (A) a wax component such as a paraffin or olefin hydrocarbon wax and (B) an olefin-maleic anhydride

Art Unit: 1713

derivative in the presence of (C) a water-soluble alkaline compound and/or a nonionic emulsifier and other conventional additives which include a protective colloid such as polyvinyl alcohol wherein the olefin-maleic anhydride derivative includes at least one of an adduct of an alpha-olefin with maleic anhydride, a copolymer of an alpha-olefin with maleic anhydride and a partially esterified product thereof. One having ordinary skill in the art would not have been endowed with any motivation to substitute a maleic anhydride grafted polyolefin for the olefin-maleic anhydride derivative of Kuroda et al with any reasonable expectation of success. Moreover, any *prima facie* case of obviousness has been diffused based on the data housed in the TABLE @ page 7.

#### Conclusion

7. The prior art, listed on the attached FORM PTO 892, is cited as of being illustrative of the general state of the art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Judy M. Reddick*  
Judy M. Reddick  
Primary Examiner

**Art Unit 1713**

JMR *Jmre*  
06/14/04